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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,294	08/02/2001	Rudolf Ehrmaier	951/50213	3900

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EXAMINER

BURCH, MELODY M

ART UNIT PAPER NUMBER

3683

DATE MAILED: 08/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,294

Applicant(s)

EHRMAIER ET AL.

Examiner

Melody M. Burch

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "18" has been used to designate both "wireless code transmission" as mentioned on pg. 6, "holding shaft" as mentioned on pg. 7, and "card insert" as shown in the figure. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the switch that is "indirectly manually actuated when the authorization verification device is inserted in the holding shaft 18" as described in the specification at the bottom of pg. 6 and the top of pg. 7. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 3, 4, and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "said means for arbitrarily preventing" in line 2.

There is insufficient antecedent basis for this limitation in the claim. Similar issues are found in claims 4 and 5.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4561527 to Nakamoto et al. in view of DE-19801064 and WO 00/37836.

Re: claims 1 and 6. Nakamoto et al. shows in figure 1 and 2A an electronic control unit C for automatically activating a parking brake in a motor vehicle as disclosed in lines 2-3 of the abstract wherein the electronic control unit automatically activates the parking brake in dependence on at least one specified operating parameter of the motor vehicle including the presence or absence of the engine operating condition signal to determine the state of the ignition power source as disclosed in col. 7 lines 32-39 and in figure 3A, but is silent as to whether or not the motor vehicle is startable without a

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mechanical key and whether or not the operating parameter is specifically the shutting-off of an internal combustion engine of the motor vehicle.

DE-19801064 teaches in lines 3-9 of the abstract the use of a transmitted code in place of the usual ignition switch to start the vehicle engine. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the ignition power source of Nakamoto et al. to have included a mechanical keyless system, as taught by DE-19801064, in order to provide a means of helping to reduce vehicle theft due to the lack of a mechanical key that is capable of being duplicated.

WO 00/37836 teaches in lines 13-14 of the abstract the use of automatically engaging the parking brakes when an internal combustion engine is turned off. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the operating parameter of Nakamoto et al. to have been the shutting off of an internal combustion engine, as taught by WO 00/37836, in order to provide a means of determining an appropriate time to apply the brakes to permit safe deceleration of the vehicle.

Re: claims 2, 3, 7, and 8. Nakamoto et al. shows in figure 2B the electronic control unit including means for arbitrarily preventing an automatic activation of the parking brake, the means being arbitrarily triggerable by a user of the motor vehicle as disclosed in col. 3 lines 15-18, the means for arbitrarily preventing comprises a key button connected with the electronic control unit, the key button being directly manually actuatable in the form of an off switch 22 for arbitrarily preventing the automatic activation of the parking brake.

Re: claim 4. Nakamoto et al., as modified, teaches the use of an electronic authorization verification device 9 having a wireless code transmission operatively arranged in the motor vehicle to start the motor vehicle and wherein the means for arbitrarily preventing comprises a holding shaft 2 in which the authorization verification device is inserted for triggering arbitrarily the prevention of the automatic activation of the parking brake. See DE-19801064 figures 1 and 2 and the abstract lines 1-9.

Re: claims 5 and 9. Nakamoto et al., as modified, teaches the use of two means of triggering arbitrarily the prevention of the automatic activation of the parking brake – first means or switch 22 and second means or switch 23 as shown in figure 2B of Nakamoto et al. DE-19801064 teaches the use of an electronic authorization verification device 9 having a wireless code transmission operatively arranged in the motor vehicle to start the motor vehicle and wherein the means for arbitrarily preventing comprises a holding shaft 2 in which the authorization verification device is inserted for triggering the turning on of the vehicle engine which in Nakamoto et al., as modified, would prevent the automatic application of the parking brake. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the second means of triggering arbitrarily the prevention of the automatic activation of the parking brake, in view of the teachings of DE-19801064, in order to provide a level of redundancy in triggering the prevention of the automatic activation of the parking brake as taught by Nakamoto et al.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 09/920293. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 2 of the instant application and claims 1 and 5 of the copending application claim an electronic control unit for automatically activation a parking brake of a vehicle startable without a mechanical key and means for arbitrarily preventing the automatic activation of the parking brake. Claim 3 of the instant application and claims 2 and 6 of the copending application claim the key button in the form of an OFF switch. Claim 4 of the instant application and claims 3 and 7 of the copending application claim the electronic authorization verification device, similarly claim 5 of the instant application parallels with claim 4 of the copending application. Claims 8, 9, and 10 of the copending application are obvious over claims 6-9 of the instant application in view of WO 00/37836. WO 00/37836 teaches in lines 13-14 of the abstract the use of automatically engaging the parking brakes when an internal combustion engine is turned off. It would have

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been obvious to one of ordinary skill in the art at the time the invention was made to have modified the operating parameter of Nakamoto et al. to have been the shutting off of an internal combustion engine, as taught by WO 00/37836, in order to provide a means of determining an appropriate time to apply the brakes to permit safe deceleration of the vehicle.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patents: 4691801 to Mann et al. teaches the use of a vehicle being startable without a mechanical key "hot wire", 6213259 to Hanson et al. teaches the use of keyless activation in an electrically powered parking brake device, 3593815 to Inoue, 5067366 to Gandiglio, 6279692 to Siepker et al., 6119837 to Tschurbanoff et al., and DE-3909907 teach the use of automatically activated parking brakes, 3985210 to Hodge et al. and 3978946 to Ream teach the use of automatically activated parking brakes that are activated when the engine shuts off.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 703-306-4618. The examiner can normally be reached on Monday-Friday (7:30 AM-4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on 703-308-3421. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

mmb 8/23/02
mmb
August 23, 2002

M.C. Graham 8/23/02
MATTHEW C. GRAHAM
PRIMARY EXAMINER
GROUP 310